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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,604	04/03/2001	Anthony Aquila	22606-05797	3275
758	7590	07/11/2006	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			GILLIGAN, CHRISTOPHER L	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/825,604	<b>Applicant(s)</b> AQUILA ET AL.	
	<b>Examiner</b> Luke Gilligan	<b>Art Unit</b> 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-25 and 36-84 is/are pending in the application.
- 4a) Of the above claim(s) 15-24 and 36-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25 and 73-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

1. In the amendment filed 4/25/06, the following has occurred: claims 26-35 have been canceled and claims 73-84 have been added. Now, claims 25 and 73-84 are presented for examination while claims 15-24 and 36-72 are withdrawn from consideration.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 73-82 and 84 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claim 73 is directed to determining a type of assignee based on an insurance claim score and an insurance claim class. The claim does not appear to result in a practical application and, rather, is directed to an abstract idea. The claim also does not result in any physical transformation. Although the determined type of assignee could potentially be used to achieve a practical application, the determination is not, in and of itself, a practical application. Therefore, claim 73 is directed to non-statutory subject matter. (See MPEP 2106).

5. Furthermore, claims 74-82 are rejected for similar reasons to claim 73 because they are also directed to mere manipulation of an abstract idea and do not result in a practical application.

6. Claims 25 and 83 are deemed to be directed to statutory subject matter because they result in the practical application of assigning the insurance claim to the assignee.

7. Claim 84 is directed to three modules for performing the steps of determining a claim score, determining a class of the insurance claim, and determining the type of assignee. Although the specification does not specifically define the term "module," the Examiner

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interprets this term, based on the specification, to be software programs. Since the modules, recited in the claims, are not tangibly embodied on a computer readable medium, the claim, as a whole, does not achieve a useful, concrete, and tangible result. Therefore, such functional descriptive material is directed to non-statutory subject matter. (see MPEP 2106).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 25, 73-81, and 84 are rejected under 35 U.S.C. 102(e) as being anticipated by Borghesi et al., U.S. Patent No. 5,950,169.

10. As per claim 25, Borghesi teaches a computer implemented method of determining a type of assignee to whom to assign an insurance claim, the method comprising: receiving data related to the insurance claim, the data comprising a plurality of data elements, a data element serving as an assignment criterion (see column 9, lines 22-29); determining a score of a data element, the score responsive to scoring rules (see column 13, lines 18-20; the Examiner interprets the "threshold total valuation number" to be a type of score as recited); determining a score of the insurance claim responsive to a score of at least one data element (see column 13, lines 18-20); determining a priority of the insurance claim according to the score of the insurance claim (see column 13, lines 14-18; the Examiner interprets the determination that total cost is approaching the threshold to be a type of determining a priority as recited); determining a

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class of the insurance claim according to classing rules (see column 12, lines 14-19 and column 13, lines 12-15; the Examiner interprets the type of vehicle to be a type of the recited class since it is used to determine values for the claim); and determining a type of assignee to whom to assign the insurance claim according to the application of business rules to the score of the insurance claim and the class of the insurance claim, wherein the business rules weight the class more highly than the score (see column 13, lines 49-53, the Examiner is interpreting the transfer of the claim to the third party service provider to be a form of assigning the claim to the third party service provider).

11. Claims 73-74, 76-77, 79, and 81 contain substantially similar limitations to those already addressed in claim 25 and, as such, are rejected for similar reasons as given above.

12. As per claim 75, Borghesi teaches the method of claim 73 as described above. Borghesi further teaches the claim score reflects a severity of the insurance claim (see column 13, lines 12-23, since the "score" of Borghesi reflects the potential cost of repair of the vehicle, it is submitted that such an indication is a reflection of the "severity" of the insurance claim as well).

13. As per claim 78, Borghesi teaches the method of claim 73 as described above. Borghesi further teaches an assignee comprises one element of a group containing an insurance adjuster, a repair facility, an appraiser, and a rental provider (see column 9, lines 24-29).

14. As per claim 80, Borghesi teaches the method of claim 79 as described above. Borghesi further teaches the effect of one data element on the claim score is greater than an effect of another data element on the claim score (see column 13, lines 18-20, the Examiner is interpreting the cost data element to have a greater effect in the context of Borghesi).

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15. Claim 84 contains substantially similar system limitations to method claim 73 and, as such, is rejected for similar reasons as given above.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 82 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al., U.S. Patent No. 5,950,169 in view of Brookes et al., U.S. Patent No. 6,950,801.

18. As per claim 82, Borghesi teaches the method of claim 73 as described above. Although Borghesi teaches profiles for potential assignees of the determined type (see column 9, lines 18-33), Borghesi does not explicitly teach determining a set of profiles with highest profile scores that include a measure of capacity to complete the insurance claim and determining the profile with the largest measure of capacity. Brookes teaches a method for assigning insurance claims to repair facilities that includes the steps of: determining a first set of profiles, wherein each profile in the first set represents a potential assignee and wherein each profile in the first set includes a profile score (see column 9, lines 2-10); determining a second set of profiles, wherein the second set contains profiles in the first set that have the highest profile scores, and wherein each profile in the second set includes a measure of capacity to complete the insurance claim (see column 11, lines 6-13); and determining from the second set of profiles, a profile with the largest measure of capacity (see column 11, lines 13-19 and lines 39-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a method of determining a best profile of a potential assignee into the

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system of Borghesi. One of ordinary skill in the art would have been motivated to incorporate such a method of the purpose of providing a more advantageous method of coordinating repair for policyholders of insurance companies by eliminating the need for repair middlemen (see column 2, lines 50-56 of Brookes).

19. As per claim 83, Borghesi in view of Brookes teach the method of claim 82 as described above. As described above, Borghesi does not explicitly teach the method for determining the profile with the largest measure of capacity. However, Brookes further teaches assigning the insurance claim to the potential assignee represented by the determined profile (see column 11, lines 39-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a method of determining a best profile of a potential assignee into the system of Borghesi for the reasons given above with respect to claim 82.

***Response to Arguments***

20. In the remarks filed 5/25/06, Applicants argue in substance that Borghesi fails to teach a step of determining a type of assignee to whom to assign the insurance claim. In response to Applicants' argument, the Examiner respectfully submits that in the portions of Borghesi cited above, the transfer of the claim to the third party service provider is interpreted to be a form of assigning the claim to the third party service provider (see column 13, lines 49-53) as claimed. Although Applicants' remarks identify column 9, lines 24-29 of Borghesi as mentioning claim assignment data, the remarks fail to specifically address the portions of the reference cited above. Therefore, the Examiner respectfully maintains that Borghesi teaches this feature as claimed.

***Conclusion***

21. Applicant's amendment, adding new claims 73-84, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

22. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

7/7/06

  
C. LUKE GILLIGAN  
PATENT EXAMINER